the Applicant's specification and claims refer to those page and line numbers as reproduced in the "Version With Markings To Show Changes", attached hereto.

§ 102 Rejection

¶7. The Examiner has rejected claims 2, 5, 8 and 9 under 35 U.S.C. § 102 (b) based on Kilby, U.S. Patent 3,667,797. Applicant has amended independent claims 8 and 9 to distinguish over the Kilby reference as explained below.

1. Kilby's Openings Are Not For Receiving Mounting Members.

¶8. The Examiner states in paragraph 2 of her Office Action dated 8/13/01 that the bores (openings 50) of the Kilby reference could receive mounting members and are therefore adapted to receive such members. Applicant has amended claims 8 and 9 so that Applicant's bores 22 are for receiving mounting members, rather than being adapted to receive them. Applicant's amended language is narrower in that it assigns a mandatory purpose to the bores 22, rather than the broader 'adapted to' language that neither distinguishes the bore's purpose nor requires a specific use for the bore.

¶9. Kilby's openings 50 are several of the spaced apertures that define a substantially triangular lattice, with a web between the apertures. Kilby, col. 2, lines 71 to col. 3, line 2. The specific openings 50 form the base corners of that triangle. Kilby, col. 3, lines 32-35. The webbed lattice *must* be readily deformable to form Kilby's tree receiving pocket 36. Kilby, col. 3, lines 66-70 (emphasis added). Additionally, when Kilby's invention is applied to branches or

trunks smaller than optimal, it is preferable to position such branches nearer the openings 50 than the center of the pocket 36 to provide sufficient rigidity. Kilby, col. 4, lines 22-30. Kilby's openings 50 are for increasing deformability in the section of the pad defining the tree receiving pocket. Applicant's amended claims 8 and 9 now require the bores 22 be for receiving mounting members. The components of the different inventions are for different purposes.

¶10. Kilby's openings 50 cannot simultaneously serve both purposes: increase deformability and receive a mounting member. To the best of Applicant's knowledge, the art currently teaches that tree shaking apparatus that employ pads to grip a tree universally incorporate mounting members that are rigid and solid. Kilby teaches the same by his jaws 17 and 18. To insert such a solid and rigid member into Kilby's openings 50 is to frustrate the ready deformability for which Kilby's openings 50 are imposed. The presence of a solid member within an opening 50 reduces the effective size of that opening, necessarily reducing the ease and extent of the tree receiving pocket's deformability. "The apertures are individually formed and arranged to provide a readily compressible tree receiving pocket." Kilby, col. 2, lines 67-69. Thus the mere insertion of a mounting member in the openings 50 is inconsistent with the operation of Kilby's web and openings, so the openings 50 cannot simultaneously be for both ready compressibility and receiving a mounting member. The Examiner is precluded from modifying the prior art in a way that would change that prior art's principle of operation. *In re Ratti*, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959); M.P.E.P. § 2143.01.

2. Kilby Fails to Teach End Sections Defining a Bore.

¶11. The Examiner asserts that the Kilby reference teaches a bore extending longitudinally through each end section, as recited in claims 8 and 9 of the instant application. Office Action dated 8/13/01, paragraph 2. Pending claims 8 and 9 each stipulate a pad comprising only two components: a web and a pair of parallel end sections at opposite ends of the web, wherein the end sections include a bore. Claim 8, lines 4-5; claim 9, lines 4-5. The claim language unambiguously encompasses end sections distinct from the web itself, each end section having a bore.

¶12. Kilby clearly teaches that the openings 50 are an inherent part of the web section. Kilby, col. 2, line 62 to col. 3, line 2; col. 3, lines 17-37; col. 3, line 60 to col. 4, line 2; and col. 4, lines 22-32. By definition, an object cannot be separated from that which it defines. Each of Kilby's openings 50 define a portion of the web, and therefore cannot be construed as within an end section distinct from that web. Numerous analogies make this clear. A ceiling tile that defines a ceiling can never become a part of an adjoining wall. To construe it as such is to deprive the ceiling of a defining element, eliminating the ceiling in redefining the tile. An anode that defines a battery cannot become a component of a starter solenoid. To redefine the anode in that way is to eliminate the battery. Pending claims 8 and 9 require two distinct components: a web and end sections defining bores. Kilby discloses a web defined in part by the openings 50. To redefine the openings 50 as within end sections is to leave undefined Kilby's web, leaving the

reference with no web to anticipate Applicant's resilient polymeric web. To retain the openings 50 within the web as Kilby requires (Kilby, col. 2, lines 71 to col. 3, line 2; col. 3, lines 32-35; and col. 3, lines 66-70) is to leave Kilby with end sections lacking the applicant's bores.

¶13. Applicant respectfully contends that pending claims 8 and 9 as herein amended now distinguish over the Kilby reference and satisfy 35 U.S.C. § 102.

§ 103 Rejections

¶14. The Examiner has rejected claims 3-4 under 35 U.S.C. § 103 (a) based on Kilby in view of Favor, U.S. Patent 3,771,301; and claim 6 under 103 U.S.C. § 103 (a) based on Kilby in view of Korthuis, U.S. Patent 5,666,796.

¶15. Pending claim 6 depends from claim 8, and requires both the web and the end sections be fabricated from polyethylene. Claim 6, lines 1-2. Kilby discloses a pad with a web and end sections. Korthuis discloses a fiberglass beater rod encased in polyethylene.

¶16. Applicant contends that there is no motivation in the art to combine Kilby with Korthuis. Kilby relates to an apparatus for harvesting fruit or nuts that operates by firmly gripping the trunk of a tree with a pair of pads and shaking the tree. Kilby opines that prior art pads are not sufficiently resilient and may damage the tree. Kilby, col. 1, lines 44-50. Korthuis relates to an apparatus for harvesting fruit that operates by inserting flexible rods within the interior of the

bush and shaking the rods to physically strike the fruit to be harvested. Korthuis relates that prior art fiberglass rods themselves are subject to damage. Korthuis, col. 1, lines 53-59. Korthuis employs a polyethylene sheath to protect the fiberglass rods from that damage. Korthuis, col. 2, lines 34-41 and 51. While both references pertain to the fruit harvesting art generally, they each harvest in a fundamentally different way, and the inventions themselves seek to protect different things. As such, Kilby's call for a resilient material for a pad that grips a tree trunk would not be evident from Korthuis' explanation of polyethylene as advantageous for its compressive forces on a fiberglass core. Korthuis, col. 2, lines 42-46. The advantage Korthuis gains from polyethylene is achieved by melting it about a fiberglass rod. Korthuis, col. 2, lines 47-50; col. 9, lines 50-55. Melting polyethylene about a tree trunk to firmly grip the trunk is clearly beyond Kilby's scope.

¶17. Additionally, Korthuis' teaches away from using polyethylene for gripping a tree trunk or branch, as Kilby's pad does. Korthuis devotes the majority of his specification to analyzing forces on beater rods and what causes them to break. Korthuis, col. 6, line 33 to col. 10, line 34, and Figures 3-6. Korthuis discounts any advantage in the polyethylene sheath contacting the tree, since flex in the underlying fiberglass rod remains unchanged. Korthuis, col. 8, lines 58-67. Korthuis expressly isolates the purpose of the sheath to a single function; to exert uniform, radially inward compressive forces on the fiberglass rod. Korthuis, col. 9, lines 50-61, and Figure 6. Korthuis thus teaches only one lesson regarding polyethylene: it is advantageous for its radially compressive

forces. This explicit single focus teaches away from exploiting any other advantages of polyethylene. At the very least, Korthuis fails to suggest a combination for purposes other than radial compressibility. Therefore, Applicant respectfully contends that pending claim 6 is not obvious from the combination of Kilby and Korthuis.

¶18. Applicant has added claims 10-15 to further distinguish over the art of record. The entire specification and claims as herein amended are reproduced in the attached "Version With Markings To Show Changes" for the Examiner's convenience, to preclude confusion in reference lines that may arise from the several changes to date. Reconsideration and allowance of the instant application is respectfully requested. The Applicant would welcome the opportunity to correct by conference any claim language choices to which the Examiner may object in order to expedite prosecution of this application.

Respectfully submitted,

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